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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/735,651	12/16/2003	Hugh E. McLoone	003797.00787	3533

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EXAMINER

NGUYEN, ANTHONY H

ART UNIT

PAPER NUMBER

2854

DATE MAILED: 08/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/735,651

Applicant(s)

MCLOONE ET AL.

Examiner

Anthony H Nguyen

Art Unit

2854

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 December 2003 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 12/16/2003.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-9 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-22 of U.S. Patent No. 6,712,535. Although the conflicting claims are not identical, they are not patentably distinct from each other because the slightly different and broader claim language.

### ***Claim Rejections - 35 U.S.C. § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 2854

A person shall be entitled to a patent unless --

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

Claims 1 and 2 are rejected under 35 U.S.C. 102(e) as being anticipated by Bruck et al. (US 6,677,927).

Bruck et al. teaches a keyboard 18,20 having a rotatable wheel 28 configured to provide a scrolling command as shown in Figs 1-2B.

Claims 3-5,8 and 9 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over Bruck et al. (US 6,677,927) in view of Griffin et al. (US 6,489,950). With respect to claims 3 and 4, Bruck et al. teaches all that is claimed, except for the rotatable wheel which has the outer diameter being larger at the first side than the outer diameter at the second side. Griffin et al. teaches a keyboard 4008 having a rotatable frustum-shaped member or a rotatable wheel 4002 which has the outer diameter at the first side which is larger than the outer diameter at the second side as shown in Figs. 9-11 of Griffin et al. In view of the teaching of Griffin et al., it would have been obvious to one of ordinary skill in the art to modify the wheel of Bruck et al. by the rotatable wheel as taught by Griffin et al. for increasing comfort of operating the rotatable wheel on a keyboard. With respect to claim 5 and 9, the selection of a desired key having an assigned function such as cut, copy or paste or a desired distance between the key and the rotatable frustum-shaped member would be obvious through routine experimentation in order to get more comfort of operating a keyboard. With respect to claim 8, the use of an input element in a keyboard that provides a back command is well known in the art.

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Claims 6 and 7 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over Bruck et al. in view of Griffin et al. as applied to claims 3-5,8 and 9 above, and further in view of Kim (US 6,404,415).

Bruck et al. et al. and Griffin et al. teaches a keyboard having substantially the structure as recited except for the raised ridge. Kim teaches a keyboard 26 having a planar section 60, a raised ridge (no numeral reference, the ridge can be seen between 66,68) in which the rotatable wheel 82 is located as shown in Figs.2-4 of Kim. In view of the teaching of Kim, it would have been obvious to one of ordinary skill in the art to modify the keyboard of Bruck et al. and Griffin et al. by providing a raised ridge as taught by Kim for protecting a rotatable wheel from inadvertently rotating the wheel.

Claims 1-4 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Griffin et al. (US 6,489,950).

Griffin et al. teaches a keyboard 4008 having a rotatable frustum-shaped member or a rotatable wheel 4002 which has the outer diameter at the first side which is larger than the outer diameter at the second side as shown in Figs. 9-11 of Griffin et al.

Claims 5,8 and 9 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over Griffin et al. (US 6,489,950).

With respect to claim 5 and 9, Griffin et al. teaches all that is claimed except for the Cut key, the Copy key and the Paste key located within 3 cm of the rotatable frustum-shaped member. However, the selection of a desired key having an assigned function such as cut, copy or paste or a desired distance between the key and the rotatable frustum-shaped member would be obvious through routine experimentation in order to get more comfort of operating a keyboard. With respect to claim 8, the use of an input element in a keyboard that provides a back command is well known in the art.

Claims 6 and 7 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over Griffin et al. as in view of Kim (US 6,404,415).

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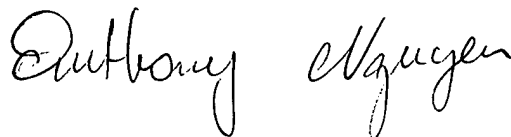
With respect to claims 6 and 7, Griffin et al. teaches a keyboard having substantially the structure as recited except for the raised ridge. Kim teaches a keyboard 26 having a planar section 60, a raised ridge (no numeral reference, between 66,68) in which the rotatable wheel 82 is located as shown in Figs.2-4 of Kim. In view of the teaching of Kim, it would have been obvious to one of ordinary skill in the art to modify the keyboard of Griffin et al. by providing a raised ridge as taught by Kim for protecting a rotatable wheel from inadvertently rotating the wheel.

### *Conclusion*

The patents to Will, Niitsuma and Grant are cited to show other structures having obvious similarities to the claimed structure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Nguyen whose telephone number is (571) 272-2169. The examiner can normally be reached daily from 9 AM to 5PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld, can be reached on (571) 272-2168. The fax phone number for this Group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.



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